UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GLEN R. WALTERS and VICTOR S. MOORE

Appeal No. 2005-2153
Application No. 09/299,309

ON BRIEF

Before RUGGIERO, BARRY, and SAADAT, *Administrative Patent Judges.*
BARRY, *Administrative Patent Judge.*

A patent examiner rejected claims 1-24. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

I. BACKGROUND

The invention at issue on appeal simulates a low-bandwidth. Programmers who develop "network centric" software for use by home computers typically work on high speed networks. (Spec. at 1.) Because many of the home computers targeted by the software use network connections in the 28.8 kilobits-per-second ("kbps") range,

however, the programmers never experience their software from the viewpoint of a typical user. (*Id.* at 1-2.)

Accordingly, the appellants' invention simulates a low-bandwidth connection over a higher-bandwidth connection. More specifically, a speed control layer is placed between two devices. The speed control layer adjusts the speed at which data are transferred from one device to the other. Therefore, assert the appellants, a programmer can experience a program being developed from the standpoint of a typical user. (*Id.* at 3.)

A further understanding of the invention can be achieved by reading the following claim.

15. A computer system comprising:

a first device transferring data at a first speed;

a second device, the second device being a client device; and

a speed control layer coupled between the first and second devices, the speed control layer limiting the maximum data transfer speed of a high-bandwidth connection between the speed control layer and the second device so as to transfer data from the first device to the second device over a high-bandwidth connection at a second predetermined speed that is less than the first speed and less than the normal speed of the high-bandwidth connection.

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as obvious over *A Teletraffic Analysis of Dial-up Connections over PSTN* ("Garroppo") and *Internet Basics* ("Jones").[1]

II. OPINION

"Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween." *Ex parte Muresan*, No. 2004-1621, 2005 WL 951659, at *1 (Bd.Pat.App & Int. Feb 10, 2005). To wit, the examiner makes the following assertions.

> "[D]owngrading" from a 33.6 kbps connection to a 28.8 kbps connection would teach going to a slower connection. In order to accomplish the above example, the modem hardware/software would have to be modified at the access server (and possibly at the client site) such that the access server performs a function of limiting. *Garroppo* teaches such a function. Hence an infinite connection is "downgraded" to a 33.6 kbps or 28.8 kbps connection thus meeting the claim limitation.

(Examiner's Answer at 6.) The appellants argue, "while upgrading or changing hardware does allow a connection between two devices at one speed to later become a connection between the two devices at another speed, it does not limit a connection at

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[1]"We advise the examiner to copy his rejections into his examiner's answers," *Ex parte Metcalf*, 67 USPQ2d 1633, 1635 n.1 (Bd.Pat.App.& Int. 2003), rather than merely referring to a "rejection . . . set forth in a prior Office Action. . . ." (Examiner's Answer at 3.)

a specific speed that exists between two devices so as to transfer data between the two devices at some speed that is less than the specific speed of that connection at that time." (Appeal Br. at 7.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, independent claim 15 recites in pertinent part the following limitations:

> limiting the maximum data transfer speed of a high-bandwidth connection between the speed control layer and the second device so as to transfer data from the first device to the second device over a high-bandwidth connection at a second predetermined speed that is less than the first speed and less than the normal speed of the high-bandwidth connection.

Independent claims 1, 9, and 20 include similar limitations. Accordingly, claims 1, 9, 15, and 20 require limiting the speed at which data are transferred between two

devices to a speed less than the speed permitted by the connection between the devices.

B. OBVIOUSNESS DETERMINATION

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (Bd.Pat.App & Int. May 20, 2004). "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Garroppo discloses a "number of users adopting dial-up access to the Internet. . . ." P. 1190, § 1. More specifically, Figure 1 of the reference shows "an access server directly connected to the Internet and equipped with a fixed number of

analog modems," p. 1191, § 2, via which the users' computers, Fig. 1, can access the Internet. Garroppo explains that "[o]n August 1995 there were only six 28.8 Kbps modems and after several upgrades, the modem number grew to 16, each one with a net link speed of 33.6 Kbps." *Id.* For our part, we are unpersuaded that the reference limits the speed at which data are transferred between the users' computers and the access server to a speed less than the speed permitted by the dial-up connection between therebetween. To the contrary, we agree with the appellants that if a user's computer employs a 28.8 kbps modem, "data [are] transferred from the access server to the client device [i.e., user's computer] at 28.8 kbps (i.e., the speed of the connection that then exists between the client device and the access server)." (Appeal Br. at 7.) "If the client device is then upgraded to have a 33.6 kbps modem, the client device will then be able to make a connection with the access server at a speed of 33.6 kbps such that data [are] transferred from the access server to the client device at 33.6 kbps (i.e., the speed of the connection that then exists between the client device and the access server)." (*Id.*)

Here, the examiner does not allege, let alone show, that the addition of Jones cures the aforementioned deficiency of Garroppo. Absent a teaching or suggestion of limiting the speed at which data are transferred between two devices to a speed less

than the speed permitted by the connection between the devices, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claims 1, 9, 15, and 20, and of claims 2-8, 10-14, 16-19, and 21-24, which respectively depend therefrom.

III. CONCLUSION

In summary, the rejection of claims 1-24 under § 103(a) is reversed.

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

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